

REMARKS

The applicants have carefully considered the official action dated March 21, 2006, and the references it cites. Claims 1-29 are pending and at issue in this application, of which claims 1, 9, 16, 22, and 28 are independent. By way of this response, the applicants have amended paragraphs [0002], [0025], [0028], and [0037] of the specification. The applicants have also amended claims 1, 2, 9, 10, 16, 22, 24, and 28 to clarify the scope of protection sought. It is respectfully submitted that no new matter has been added. In view of the foregoing amendments and the following remarks, the applicants traverse the rejections and respectfully submit that all pending claims are in condition for allowance. Favorable reconsideration is respectfully requested.

I. The Requirement for Information under 37 C.F.R. § 1.105

In the official action, the examiner requested, pursuant to 37 C.F.R. § 1.105, that the applicant point out particular pages of relevancy in a reference previously submitted via an information disclosure statement. In addition, the examiner indicated via phone conference on June 20, 2006, that the requirement for information under 37 C.F.R. § 1.105 pertained to the Extensible Firmware Interface Specification, version 1.10, December 1, 2002, submitted via an information disclosure statement by the applicants on January 15, 2004. Accordingly, in response to the examiner's request for information concerning the Extensible Firmware Interface Specification, version 1.10, December 1, 2002, the applicants have prepared and submit herewith a PTO-1449 form indicating particular pages that may be of interest to the examiner. In addition, the applicants have attached hereto courtesy copies of those pages indicated on the PTO-1449 form. In particular, the applicants have indicated and attached the following pages: Ch1: 6-11; Ch2: 1-5 and 17-20; Ch3: 1-8; Ch5: 26-27; Ch8: 1; Ch11: 2-6, 12, 13, and 16; Ch12: 46; Ch19: 1-3 and 76; and Glossary: 15. Accordingly, the applicants respectfully request withdrawal of the requirement for information under 37 C.F.R. § 1.105.

In addition, although the applicants have provided the above-referenced pages that they feel may be of interest to the examiner, the applicants respectfully request that the examiner consider all pages of the Extensible Firmware Interface Specification to determine whether it contains any additional information that the examiner deems pertinent to the pending claims. Accordingly, the applicants re-submit in the above-mentioned PTO-1449 form a citation to all pages of the Extensible Firmware Interface Specification, version 1.10, December 1, 2002. In considering all pages of the document, the examiner may elect to perform an electronic search in an electronic copy of the document. The examiner may retrieve an electronic copy of the Extensible Firmware Interface Specification at <http://www.intel.com/technology/efi>. Alternatively, if the examiner wishes, the applicants may forward an electronic copy to the examiner upon request via electronic mail or CD-ROM.

II. The Objections to the Specification

In the official action, the drawings were objected to under 37 C.F.R. § 1.84(p)(5) as including reference numbers not mentioned in the description. The applicants submit herewith amended paragraphs [0025] and [0028] including reference numeral 300 and an amendment to paragraph [0037] including reference numeral 512. Accordingly, the applicants respectfully submit that the specification complies with 37 C.F.R. § 1.121(b) and respectfully request withdrawal of the objection to the drawings.

III. The Rejections under 35 U.S.C. § 112

In the official action, claims 2-8, 10-15, 17-21, 23-27, and 29 were rejected under 35 U.S.C. § 112, second paragraph as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicants respectfully submit that claims 2-8, 10-15, 17-21, 23-27, and 29 comply with 35 U.S.C. § 112, second paragraph.

With regard to claim 2, the applicants have amended claim 2 to include “the compatibility support module” to provide the proper antecedent basis with respect to “a compatibility support module” of claim 1. In regard to claims 2-8, 10-15, 17-21, 23-27, and 29, it is well established law that each claim is a separate invention. *See Honeywell INt'l Inc. v. Hamilton Sundstrand Corp.*, 370 F.3d 1131, 1148-49 (Fed. Cir. 2004) (citing 35 U.S.C. § 282) (“Each claim defines a separate invention, whether or not written in independent form...”). To this end, each claim defines a class of inventive embodiments. Therefore, it is appropriate to use the “A” introduction for each claim. This is evident from the fact that such practice has been used in hundreds of issued patents. *See* U.S. 6,834,133 (December 2004); U.S. 6,959,028 (October 2005); and U.S. 6,963,894 (November 2005). In addition, the Manual of Patent Examining Procedure (“MPEP”) shows example dependent claims using the “A” introduction. *See MPEP* § 608.01(n), subheading A. Accordingly, the applicants submit that claims 2-8, 10-15, 17-21, 23-27, and 29 comply with 35 U.S.C. § 112, second paragraph and respectfully request withdrawal of the § 112 rejection therefrom.

IV. The Rejections under 35 U.S.C. §§ 102(e) and 103(a)

In the official action, claims 1, 4, 5, 7-9, 12, 14-16, 18, 20-23, 25, and 27-29 were rejected under 35 U.S.C. § 102(e) as anticipated by Fish et al. and claims 2, 3, 10, 11, 17, and 24 were rejected under 35 U.S.C. § 103(a) as unpatentable over Fish et al. in view of Yoon et al. The applicants respectfully submit that independent claim 1 is allowable over the art of record. Independent claim 1 is directed to a method and recites, *inter alia*, locating a compatibility support module on a second computer readable medium... wherein the compatibility support module is stored on at least one of a secure area or a processor system communicatively coupled to the processor via a network. None of the art of record teaches or suggests a compatibility support module stored on at least one of a secure area or a processor system communicatively coupled to the processor via a network.


In addition, the applicants respectfully submit that 35 U.S.C. § 103(c) disqualifies Fish et al. (U.S. 2003/0110370) from being used to make an obviousness rejection in the instant application. Specifically, Fish et al. and the claimed invention were, at the time the claimed invention was made, owned by the same corporation or subject to an obligation of assignment to the same corporation. To show that Fish et al. and the claimed invention were subject to an obligation of assignment to Intel Corporation at the time of invention of the claimed invention, the applicants submit herewith a courtesy copy of the assignment of rights document filed with the United States Patent and Trademark Office in the instant application on October 21, 2003, and a Notice of Recordation of Assignment indicating that the assignment was made of record on October 24, 2003, at reel 014621, frame 0463. In addition, the applicants submit herewith a printout from the "USPTO Assignment on the Web" website indicating that the Fish et al. reference was assigned to Intel Corporation on March 28, 2002, and made of record on April 8, 2002, at reel 012790, frame 0918.

In light of the evidence showing that Fish et al. and the instant application were subject to an obligation of assignment to Intel Corporation at the time of invention of the claimed invention, the applicants respectfully request withdrawal of the obviousness rejections over the Fish et al. reference and respectfully submit that amended claim 1 is allowable over the art of record. Accordingly, the applicants respectfully submit that independent claim 1 and all claims dependent thereon are in condition for allowance.

The applicants respectfully submit that independent claims 9, 16, 22, and 28 are also allowable over the art of record for at least the reasons discussed above in connection with independent claim 1. Accordingly, independent claims 9, 16, 22, and 28 and all claims dependent thereon are in condition for allowance.

In view of the foregoing, the applicants respectfully submit that this application is in condition for allowance. If there are any remaining matters that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Mark C. Zimmerman', is written over a horizontal line.

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Dated: **June 21, 2006**



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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

MAY 18, 2004

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NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 10/24/2003

REEL/FRAME: 014621/0463
NUMBER OF PAGES: 2

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:
ROTHMAN, MICHAEL A.

DOC DATE: 09/29/2003

ASSIGNOR:
ZIMMER, VINCENT J.

DOC DATE: 09/29/2003

ASSIGNOR:
HSIUNG, HARRY L.

DOC DATE: 09/29/2003

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10-28-2003

Attorney Docket No. INTEL/17582

PATENTS ONLY



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document or copy thereof.

<p>1. Name of party or parties conveying an interest:</p> <p>Michael A. ROTHMAN Vincent J. ZIMMER Harry L. HSIUNG</p>	<p>2. Name and address of party or parties receiving an interest:</p> <p>Name: Intel Corporation a Delaware corporation 2200 Mission College Blvd. Santa Clara, California 95052</p>
<p>3. Description of the interest conveyed:</p> <p><input checked="" type="checkbox"/> Assignment <input type="checkbox"/> Merger <input type="checkbox"/> Change of Name <input type="checkbox"/> Security Agreement</p> <p>Execution Date: September 29, 2003</p>	<p>Other:</p> <p>2003 OCT 24 AM 7:09 OPR/FINANCE</p>
<p>4. Application number(s) or patent number(s). Additional sheet attached? YES <input type="checkbox"/> NO <input checked="" type="checkbox"/></p> <p>A. Patent Application no.(s): 10/675,486 filed September 30, 2003</p>	<p>If the document is being filed together with a new application, the execution date of the application is:</p> <p>B. Patent no.(s):</p>
<p>5. Name and address of party to whom correspondence concerning this cover sheet should be mailed:</p> <p>Name: Mark C. Zimmerman Reg. No. 44,006 GROSSMAN & FLIGHT, LLC Street Address: 20 North Wacker Drive Suite 4220 City: Chicago State: Illinois Zip: 60606</p>	<p>6. Number of applications and/or patents identified on this cover sheet: 1</p> <p>7. Amount of fee enclosed or authorized to be charged: \$40.00</p> <p>8. Any additional required fee may be charged, or any overpayment credited to our deposit account: 50-2455</p>

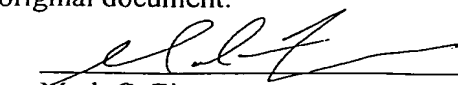
9. To the best of my knowledge and belief, the information contained on this cover sheet is true and correct and any copy submitted is a true copy of the original document.

Date: October 21, 2003

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Mark C. Zimmerman
Registration No. 44,006

Attorneys for Intel Corporation

INTEL/17582

ASSIGNMENT

Serial No: 10/675,486
Filed: September 30, 2003
Title: "METHODS AND APPARATUS TO PROVIDE CONDITIONAL LEGACY SUPPORT"

For good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the undersigned hereby assign to Intel Corporation, a Delaware corporation, 2200 Mission College Blvd., Santa Clara, California 95052, (hereinafter "assignee"), its successors and assigns, the entire right, title and interest in the invention or improvements of the undersigned disclosed in an application for Letters Patent of the United States, and in said application and any and all other applications, both United States and foreign, which the undersigned may file, either solely or jointly with others, on said invention or improvements, and in any and all Letters Patent of the United States and foreign countries, which may be obtained on any of said applications, and in any reissue or extension thereof.

The undersigned hereby authorize and request the Commissioner of Patents and Trademarks to issue said Letters Patent to said assignee.

The undersigned hereby authorize and request the attorneys of record in said application to insert in this assignment the filing date and serial number of said application when officially known.

The undersigned warrant themselves to be the owners of the interest herein assigned and to have the right to make this assignment and further warrant that there are no outstanding prior assignments, licenses, or other rights in the interest herein assigned.

For said consideration the undersigned hereby agree, upon the request and at the expense of said assignee, its successors and assigns, to execute any and all divisional, continuation, continuation-in-part and substitute applications for said invention or improvements, and any necessary oath or affidavit relating thereto, and any application for the reissue or extension of any Letters Patent that may be granted upon said application, and any and all applications and other documents for Letters Patent in foreign countries on said invention or improvements, that said assignee, its successors or assigns, may deem necessary or expedient, and for said consideration the undersigned further agree upon the request of said assignee, its successors or assigns, in the event of any application or Letters Patent assigned herein becoming involved in Interference, to cooperate to the best of the ability of the undersigned with said assignee, its successors or assigns, in the matters of preparing and executing the preliminary statement and giving and producing evidence in support thereof, the undersigned hereby agreeing to perform, upon request, any and all affirmative acts to obtain said Letters Patent, both United States and foreign, and vest all rights therein hereby conveyed in said assignee, its successors and assigns, whereby said Letters Patent will be held and enjoyed by said assignee, its successors and assigns, to the full end of the term for which said Letters Patent may be granted as fully and entirely as the same would have been held and enjoyed by the undersigned if this assignment and sale had not been made.

9/29/2003
Date
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Michael A. ROTHMAN
Vincent J. ZIMMER
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Patent Assignment Abstract of Title

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Total Assignments: 1

Patent #: [6961848](#)

Issue Dt: 11/01/2005

Application #: 10016055

Filing Dt: 12/11/2001

Publication #: [US20030110370](#)

Pub Dt: 06/12/2003

Inventors: Andrew J. Fish, Michael D. Kinney

Title: SYSTEM AND METHOD FOR SUPPORTING LEGACY OPERATING SYSTEM BOOTING IN A LEGACY-FREE SYSTEM

Assignment: 1

Reel/Frame: [012790/0918](#)

Recorded: 04/08/2002

Pages: 2

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

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Exec Dt: 03/28/2002

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Exec Dt: 03/28/2002

Assignee: [INTEL CORPORATION](#)

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